

REMARKS

The claims in the application have been amended to deal with the rejections and objections as explained in the final rejection.

Claims 35, 36 and 43 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite. The Examiner noted that R' is defined, among other things, as "an anionic hydrocarbyl ligand" but in dependent claim 35, the definition of R' includes halogenated and other hetero-substituted groups which are not hydrocarbyl. Although it is clear that applicants intended to include under hydrocarbyl said halogenated and hetero-substituted groups, the Examiner is correct that it is not commonly understood that atoms other than hydrogen and carbon are encompassed by hydrocarbyl. To remove the confusing terminology, independent claim 33 has been amended to delete "hydrocarbyl". Consequently, now there is no longer a conflict between claims 33 and 35 as to the definition of the R' group. Since the scope of the claims is no longer indefinite, the rejection should be withdrawn.

In paragraphs 3, 4 and 5 in the final rejection, the Examiner rejected the indicated claims under 35 U.S.C. 102(b) over Suld et al. (US 4,100,338) and the indicated claims under 35 U.S.C. 103(a) over Johnson et al. (US 5,714,556) and Okamoto et al (US 5,629,398). The Examiner explained that applicants' traversal of the rejections were based on the assertion that the claimed compositions could not be polymerized as such because such compositions did not contain the necessary components to induce polymerization. The Examiner noted, however, that the independent claims 32 and 44 employed the open-ended term "comprising" which makes the claims open to any additional components, including those which would induce polymerization.

Independent claims 32 and 44 have been canceled and replaced by claims 78 and 79, respectively. The new claims recite that the reactant formulation **consists essentially** of a pro- catalyst and a monomer (claim 78) or of an activator

salt and a monomer (claim 79). With regard to the phrase "consisting essentially of" the Federal Circuit has stated that "... it has long been understood to permit inclusion of components not listed in the claim, provided that they do not 'materially affect the basic and novel properties of the invention'" (see *PPG Indus. v. Guardian Indus. Corp.*, 48 USPQ2d 1351 and *AK Steel Corp. v. Sollac*, 68 USPQ2d 1280 at 1283). It is, therefore, clear that the new claims 78 and 79 are directed to a composition that cannot possibly be polymerized because claim 32 contains only a procatalyst which, by itself, cannot initiate polymerization of a monomer and claim 44 essentially consists of an activator salt and a monomer which also cannot polymerize as such.

From the Examiner's explanation in paragraph 6 of the Final Rejection, it was understood that the only reason why Applicants' arguments submitted on 9/12/2003 have not been persuasive was because of the use of the open-ended term "comprising". Since such a term is no longer employed in these claims in defining the two components of the composition, it is respectfully requested that the Examiner reconsider the rejections in paragraphs 3, 4 and 5 of the final rejection in view of new claims 78 and 79 which replace claims 32 and 44, respectively, in combination with all of the arguments made in the amendment filed 9/12/2003. It is noted that the open-ended term "comprising" is still present in the newly added independent claims, but this term refers only to the monomer component and not to the claimed compositions as a whole.

It is submitted that now the rejected claims are clearly allowable because they are not directed to compositions that can be polymerized as such and such unpolymerizable compositions are not disclosed in any of the references employed in the rejections as explained in greater detail in the amendment of 9/12/2003. Reconsideration and withdrawal of said rejections are respectfully requested.

In paragraph 7 of the Final Rejection, the Examiner stated that claims 33, 34, 37-42, 53, 54 and 59 were objected to as being dependent upon a rejected base claim. Since it is believed that the amendments discussed above have placed

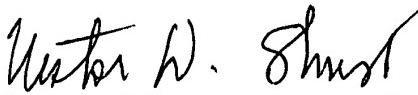
the rejected claims in condition of allowance, the objections to said claims should be withdrawn and the claims allowed.

For the above-stated reasons and in view of the amendments submitted herewith, it is submitted that now all pending claims are in condition for allowance. Reconsideration and a Notice of Allowance is respectfully requested.

Respectfully submitted,

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Attorney Docket No. 1980044B-DIV